## REMARKS

Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

Claims 1-24 are pending in the application. Claims 1-2, 6-7 and 17-22 have been amended to better define the claimed invention. New claims 23-24 have been added to provide Applicants with the scope of protection to which they are believed entitled. The amended/new claims find solid support in the original specification, e.g., at page 9, lines 25-29 and page 10, lines 8-11, and the drawings, e.g., at Figs. 2a-2c and 3a-3c. The Abstract has been revised to be complaint with commonly accepted US patent practice. No new matter has been introduced through the foregoing amendments.

The *35 U.S.C. 101* rejection of claims 19-20 is believed overcome in view of the above amendments. In particular, claims 19-20 have been amended to direct to a computer-readable <u>medium</u> which is statutory subject matter.

The *35 U.S.C. 102(b)* rejection of claims 1-22 as being anticipated by *Rosenberg* (U.S. Patent No. 6,128,006) is noted. Applicants respectfully traverse at least the rejection of independent claim 10, as the applied reference does not fairly teach or disclose each and every element of the rejected claim, namely, "the menu item focus is moveable within the menu by means of the pointing device <u>without moving the pointer.</u>" An advantage of embodiments implementing the invention of claim 10 has been disclosed in the specification, at page 17, lines 23-27.

The Examiner's reliance [1] on column 17 lines 30-38 of *Rosenberg* for the above feature of claim 10 is noted. Applicants respectfully disagree with the Examiner's holding that *Rosenberg* teaches the claim feature. The cited passage of *Rosenberg* is reproduced below for the Examiner's

convenience of review:

> For example, one standard GUI feature is a pull-down menu 206. Individual menu items 208 in the pull down menu 206 may be selected by the user using cursor 204. Once the pull-down menu has been displayed, the selection of a menu item 208 can be controlled by <u>wheel 16 moving cursor 204</u> (and, optionally, vertical motion of mouse 12 or 32 can be disabled while the menu is displayed). For example, a menu item selection bar 210 (or highlighter) can be moved up or down menu 206 by rotating the wheel 16...

A person of ordinary skill in the art upon reading the cited passage (especially the above highlighted teaching) would understand that the wheel 16, while controlling highlighter 210, also controls cursor or pointer 204.[2] Thus, if wheel 16 of *Rosenberg* is operated by a user to control up-and-down movements of highlighter 210, cursor 204 should also be moved up and down at the same time, contrary to the claim limitation that the pointer is not moved.

The above teaching of *Rosenberg* is also consistent with his disclosure else where in the specification of the prior art patent. For example, at column 19 line 55, *Rosenberg* discloses that $Y_{CURSOR} = Y_{MOUSE} + Y_{WHEEL}$. When a menu is opened, the Y position of the mouse can be ignored,[3] making $Y_{CURSOR} = Y_{WHEEL}$. It is apparent to the person of ordinary skill in the art that, again, the user's manipulation of the wheel 16 to move highlighter 210 up or down (i.e., changing $Y_{WHEEL}$) will necessarily change $Y_{CURSOR}$ and, hence, move cursor 204 up or down, contrary to the claim limitation that the pointer is not moved.

Thus, the cited passage as well as other teachings of *Rosenberg* do not teach or disclose, at least, the above-discussed feature of independent claim 10. The reference as applied by the Examiner fails to anticipate the claim, and therefore, withdrawal of the *35 U.S.C. 102(b)* rejection of claim 10 is believed appropriate and respectfully requested.

Claims 1-9, 11-16 and new claim 23 depend from claim 10, and are considered patentable

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[1] *See* Office Action at page 5, lines 8-11.
[2] *See Rosenberg* at Fig. 9 and column 16 lines 54-55.
[3] *See Rosenberg* at column 20 lines 6-10 and column 17 lines 35-36.

at least for the reasons advanced with respect to claim 10. The dependent claims are also patentable on their own merits since these claims recite other features neither disclosed, taught nor suggested by the applied art, as will be apparent to the Examiner upon reviewing these claims.

For example, as to claim 2, *Rosenberg* fails to teach or suggest that while the menu is being opened, <u>none</u> of the two-dimension actuator and one-dimension actuator control movements of the pointer. As discussed above, when the menu 206 is being opened, the one-dimension actuator or wheel 16 still controls movements of the pointer/cursor 204 because $Y_{CURSOR} = Y_{WHEEL}$.

As to claim 6, *Rosenberg* fails to teach or suggest that the menu item focus is fixed while <u>the menu is movable</u>, upon operation of the one-dimension actuator. As can be seen in Fig. 9 of *Rosenberg*, it is the highlighter 210 that moves. Menu 206 of *Rosenberg*, contrary to the claimed invention, is fixed.

As to claim 7, *Rosenberg* fails to teach or suggest that the menu is closed by a relative <u>movement of the menu item focus out of the menu</u>.

As to claim 23, *Rosenberg* fails to teach or suggest that the menu is closed by selecting a menu closing item within the menu with the one-dimension actuator or the two-dimension actuator, wherein <u>said menu closing item, when selected, only causes closing of said menu</u>. The Examiner's rationale found in Office Action at page 4, lines 5-8 from bottom is noted. Applicants respectfully submit that it is well known in the art that if the menu item "<u>E</u>xit" in Fig. 9 of *Rosenberg* is selected, not only menu 206, but also the application window 202 will be closed. Therefore, *Rosenberg* does not teach or suggest a menu closing item the selection of which will <u>only</u> cause closing of the menu as presently claimed.

Independent claim 18 is directed to a computer comprising a display and a pointing device, wherein, among other things, after the menu has been opened and while the menu is being opened, the pointer stays at the position it was in when the menu was opened, while the menu item focus is

moveable within the menu by means of the pointing device <u>without moving the pointer</u>. Thus, independent claim 18 includes a limitation similar to the feature of claim 10 being discussed above. Thus, claim 18 is patentable over *Rosenberg* for at least the reasons presented with respect to claim 10.

Claim 17 depends from claim 18, and is considered patentable at least for the reason advanced with respect to claim 18.

Independent claim 20 is directed to a computer-readable medium containing thereon program code which, when executed on a computer system, is arranged to, among other things, after the menu has been opened and while the menu is being opened, to <u>keep the pointer, regardless of operation of the pointing device, at the position it was in when the menu was opened</u>, while enabling the menu item focus  to be moveable within the menu by means of the pointing device without moving the pointer. As discussed above with respect to claim 10, the cursor/pointer 204 of *Rosenberg* is not kept stationary at a specific position regardless of operation of the pointing device, because cursor/pointer 204 is still moved by wheel 16. Thus, claim 20 is patentable over *Rosenberg*.

Claim 19 depends from claim 20, and is considered patentable at least for the reason advanced with respect to claim 20.

Independent claim 21 is directed to a method of enabling a user of a graphical user computer interface to open at least one menu and to select an item of the menu by means of a pointing device, said method comprising, among other things, activating, when the menu is opened, the one-dimension actuator to control movement of the menu item focus within the menu, while <u>enabling the two-dimension actuator to control movements of both the menu item focus and the pointer within the menu</u>. In *Rosenberg*, there is no disclosure or suggestion that highlighter 210 is controllable by mouse 12 or 32, or that cursor 204 is controllable by mouse 12 or 32 within menu

206. Therefore, claim 21 is patentable over *Rosenberg*.

Claim 24 depends from claim 21, and is considered patentable at least for the reason advanced with respect to claim 21. The dependent claim is also patentable on its own merit, because *Rosenberg* does not fairly teach or suggest the claim feature that the menu closing item is positioned within the menu at a place unreachable by the one-dimension actuator. As can be seen in Fig. 9 of *Rosenberg*, all menu items 208 of menu 206, including "Exit," is reachable by wheel 16.

Independent claim 22 is directed to a method of enabling a user of a graphical user computer interface to open at least one menu and to select an item of the menu by means of a pointing device, said method comprising, among other things, enabling, after having opened the menu and while the menu is being opened, the menu item focus to be moved within the menu by means of the pointing device while disabling the pointing device from moving the pointer. As discussed above with respect to claim 10, the pointing device of *Rosenberg*, particularly wheel 16, is not disabled from moving cursor 204. Thus, claim 22 is patentable over *Rosenberg*.

Each of the Examiner's rejections has been traversed/overcome. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 08-2025 and please credit any excess fees to such deposit account.

Respectfully submitted,

**Christian S. SEIFERT**
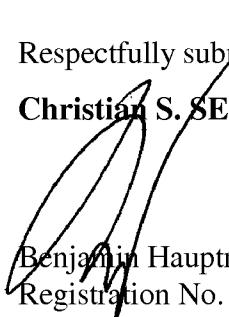
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